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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86150955
Applicant	K & N Distributors
Applied for Mark	DERMOPLUS GEL
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	K & N Distributors	:	
Serial No.:	86/150,955	:	Examining Attorney: C. S. Young
Filed:	December 23, 2013	:	
		:	Law Office: 117
Mark:	DERMOPLUS GEL	:	

BRIEF OF THE APPLICANT

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I. INTRODUCTION

COMES NOW the Applicant K & N Distributors (hereinafter "Applicant"), by counsel Matthew H. Swyers, Esq., The Trademark Company, PLLC, and submits the instant Brief of the Applicant in support of Applicant's contention that the instant mark should be permitted to register.

II. STATEMENT OF THE CASE

On or about December 23, 2013 K & N Distributors applied to register the trademark DERMOPLUS GEL in connection with "cosmetics" in International Class 03. The application was filed as an intent-to-use application under Section 1(b) of the Act. Moreover, the application included a voluntary disclaimer of the term GEL.

On March 28, 2014 the Office conducted its initial review of the application. At that time the Office refused registration of the Applicant's trademark on the grounds that, if registered, applicant's trademark would create a likelihood of confusion with U.S. Registration Nos. 2324254, DERMA PLUS used on or in connection with the following goods in International Class 05: "Skin care products, namely, medicated skin care lotions sold in aerosol containers." The registrant of this service mark is listed as Benchmark Commercial, Inc.

On or about September 29, 2014 Applicant, by Counsel, submitted a response. The examining attorney, being unpersuaded by the argument, issued a Final refusal on or about November 6, 2014. The instant brief now timely follows.

III. ARGUMENT IN SUPPORT OF REGISTRATION

The Standard for a Determination of a Likelihood of Confusion

A determination of likelihood of confusion between marks is determined on a case-specific basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The

examining attorney is to apply each of the applicable factors set out in *In re E.I. du Pont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The relevant *du Pont* factors are:

> (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
>
> (2) the similarity or dissimilarity and nature of the services as described in an application or registration or in connection with which a prior mark is in use;
>
> (3) the similarity or dissimilarity of established, likely-to-continue trade channels;
>
> (4) the conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing;
>
> (5) the number and nature of similar marks in use on similar services; and
>
> (6) the absence of actual confusion as between the marks and the length of time in which the marks have co-existed without actual confusion occurring.
>
> *See id.*

The examining attorney is required to look to the overall impression created by the marks, rather than merely comparing individual features. *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1029, 10 USPQ2d 1961 (2d Cir. 1989). In this respect, the examining attorney must determine whether the total effect conveyed by the marks is confusingly similar, not simply whether the marks sound alike or look alike. *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1870 (10th Cir. 1996) (recognizing that while the dominant portion of a mark is given greater weight, each mark still must be considered as a whole)(*citing Universal Money Centers, Inc. v. American Tel. & Tel. Co.*, 22 F.3d 1527, 1531, 30 USPQ2d 1930 (10th Cir. 1994)). Even the use of identical dominant words or terms does not automatically mean that two marks are similar. In *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442 (8th Cir. 1987), the court held that "Oatmeal

Raisin Crisp" and "Apple Raisin Crisp" are not confusingly similar as trademarks. Also, in *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1874 (10th Cir. 1996), marks for "FirstBank" and for "First Bank Kansas" were found not to be confusingly similar. Further, in *Luigino's Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, the mark "Lean Cuisine" was not confusingly similar to "Michelina's Lean 'N Tasty" even though both marks use the word "Lean" and are in the same class of services, namely, low-fat frozen food.

Concerning the respective goods or services with which the marks are used, the nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration. *See, e.g., Hewlett-Packard Co. v. Packard Press Inc.,* 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.,* 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald's Corp*., 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973). *See generally* TMEP § 1207.01(a)(iii).

If the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are similar confusion is not likely. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for

advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.,* 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (*e.g.,* lamps, tubes) related to the photocopying field). *See generally* TMEP § 1207.01(a)(i).

Moreover the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune from source confusion. *See In re Decombe,* 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.,* 221 USPQ 558 (TTAB 1983). However, circumstances suggesting care in purchasing may tend to minimize likelihood of confusion. *See generally* TMEP § 1207.01(d)(vii).

Applying the legal standards as enumerated above, it is clear that confusion is not likely to exist and Applicant's mark is entitled to register despite the existence of the cited mark.

A. Dissimilarity In the Marks' As to Their Respective Appearances

The Applicant applied to register the mark DERMOPLUS GEL. The cited mark is DERMA PLUS (U.S. Reg. No. 2,324,254.) Copies of the applications for Applicant's mark and for the blocking mark were previously made of record as Exhibits 1-2 in Applicant's office action response.

From an initial context, Applicant must concede the phonetic equivalence of DERMOPLUS versus DERMA PLUS. Moreover, as the Applicant has disclaimed GEL apart from its mark as a whole, Applicant must concede the highly similar nature of the first cited trademark against its mark.

Generally, the existence of third-party registrations cannot justify the registration of another mark that is similar to a previously registered mark as to create a likelihood of confusion, or to cause mistake, or to deceive. *E.g., In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1248

(TTAB 2010); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272 (TTAB 2009). However, third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, *or so commonly used that the public will look to other elements to distinguish the source of the goods or services*. *See, e.g., In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012)(*emphasis added*); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eaglemotive Inc.*, 9 USPQ2d 1910, 1911-12 (TTAB 1988); *Plus Prods. v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983). In the case with the DERMOPLUS GEL mark, the term DERMO has consistently been treated as weak with respect to similar goods, therefore consumers must rely on other factors, in this case the addition of the word GEL to the mark, as well as the differences in goods, trade and marketing channels to be distinguished.

There can be no doubt that both the Applicant's mark and that of the Registrant contain the terms, or phonetic equivalent thereto the term "DERMO" In this regard, Applicant respectfully submits the following Exhibits 3 through 18 (previously made of record with Applicant's office action response) which display 15 registered marks incorporating the term "DERMO" and literal equivalents thereof used in relation to similar goods. The marks are as follows:

> DERMO EVOLUTION, U.S. Reg. No. 4539695 owned by Amégnizin, Louis, used in connection with "Cosmetics; essential oils for personal use; skin cream; skin lotion; skin soap" in International Class 03. *See* Exhibit 3;
>
> DERMONÙ, U.S. Reg. No. 4372881, owned by Win Direct S.L., used in connection with "non-medicated acne preparations" in International Class 03. *See* Exhibit 4;
>
> DERMO REAL, U.S. Reg. No. 3755733, owned by Saflosa Industria Real, S.A. DE C.V, used in connection with "Body cream; Body lotion; Face and body creams; Face and body lotions; Face creams; Moisturizing creams" in International Class 03. *See* Exhibit 5;

DERMOLYSE, U.S. Reg. No. 3351989, owned by Cosmétiques France-Laure (1970), used in connection with "Skin care cosmetics, namely, face lotions, facial creams, hand cream, hand lotion, body cream, body lotion and body powder" in International Class 03. *See* Exhibit 6;

DERMOBIOTIC, U.S. Reg. No. 3487232, owned by Biotherm Societe Anonyme Monegasque, used in connection with "Cosmetics" in International Class 03. *See* Exhibit 7;

DERMOPLAST, U.S. Reg. No. 0698867, owned by Doho Chemical Corporation, used in connection with "Aerosol Anesthetic Preparation for the Relief of Surface Pain." in International Class 05. *See* Exhibit 8;

DERMOZYME, Reg. No. 2931126, owned by SynZyme Technologies, Inc., used in connection with "Topical gel for medical and therapeutic use for use to prevent ultra violet radiation damage, psoriasis, alopecia, skin aging, and to reduce inflammation after laser cosmetic surgery, for human use." in International Class 05. *See* Exhibit 9;

DERMADAILY, U.S. Reg No. 4601040, owned by DermaRite Industries, used in connection with "Beauty creams; Beauty creams for body care; Face creams for cosmetic use; Facial cream; Moisturizing creams; Non-medicated skin care creams and lotions" in International Class 03. *See* Exhibit 10;

DERMATOX, U.S. Reg. No. 4323352, owned by The Oncor Corporation DBA Danne Montague-King Co. in connection with "skin care preparations, namely, astringents for cosmetic purposes, cosmetic preparations for skin renewal, antiperspirants and deodorants for personal use, and hair care preparation" in International Class 03. *See* Exhibit 11;

DERMAROSE, U.S. Reg. No. 4516427 owned by Brand Development Corp, used in connection with "anti-aging cream, skin moisturizer, eye cream, face cream, body cream" in International Class 03. *See* Exhibit 12;

DERMATRUTH, U.S. Reg. No. 4507779, owned by Calvarese, Michelle, used in connection with "Non-medicated skin care preparations" in International Class 03. *See* Exhibit 13; and

DERMAGEAR, U.S. Reg. No. 4272067, owned by Kiage Team Inc., used in connection with "Non-medicated skin care preparations" In International class 03. *See* Exhibit 14;

DERMANEX, U.S. Reg. No. 4318495, owned by Kim, Kevin, used in connection with "Cosmetics" in International Class 03. *See* Exhibit 15;

DERMABON, U.S. Reg. No. 4126829, owned by LICONA SAENZ, JOSE MARIA, used in connection with " Medicated soap" in International Class 03. *See* Exhibit 16;
DERMASLIM, U.S. Reg. No. 4019623, owned by truDERMA LLC, used in connection with "Beauty creams for body care; Creams for cellulite reduction; Lotions for cellulite reduction; Skin and body topical lotions, creams and oils for cosmetic use" in International Class 03. *See* Exhibit 17; and

DERMATOCLEAN, U.S. Reg. No. 4030602, owned by Beiersdorf AG, Inc., used in connection with "Cosmetic soaps; medicated soaps; cosmetic preparations for body and beauty care" in International Class 03, and "Medicated skin care preparations for body and beauty care; medicated dermatological preparations for body and beauty care" in International Class 05. *See* Exhibit 18.

Accordingly, based upon consideration of the dilution of the term "DERMA" and literal and phonetic equivalents thereof as it relates to marks in related classes, Applicant respectfully submits that this *du Pont* factor favors a finding of an absence of a likelihood of confusion between the marks and merely requests the Board to ratify the instant refusal by determining that the Applicant's mark is simply not sufficiently similar to the registration.

B. Dissimilarity Between the Marks' Respective Goods

Comparing the goods of the Applicant and the goods of the cited mark, it is apparent that the goods of the Applicant differ significantly from the goods of the cited mark. Applicant's mark is used exclusively in connection with cosmetics. Specifically, the DERMOPLUS GEL mark is used with a non-medicated cosmetic gel used to beautify skin. In the alternative, the DERMA PLUS is used with "skin care products, namely, medicated skin care lotions sold in aerosol containers." *See* Exhibit 2 previously made of record in Applicant's office action response. The specimen of use submitted under the DERMA PLUS mark shows the lotion is used specifically in a first-aid environment. *See* Exhibit A of Exhibit 19, Affidavit of Jean Robert Cesar previously made of record in Applicant's office action response.

Of note, Applicant respectfully submits that the Registrant appears to have changed the name DERMA PLUS to "Derma Shield Plus," according to Registrant's product page on the website found at www.dermashieldusa.com, leading one to believe the instant blocking mark DERMA PLUS is no longer in use in commerce. Attached are pages posted to Registrant's website showing the same. *See* Exhibit B of Exhibit 19 previously made of record.

It is respectfully submitted that there is little, if any, relation between the cosmetic goods of the Applicant and the first-aid goods found under the cited mark and, as such, this *du Pont* factor also favors a finding of an absence of a likelihood of confusion between the instant marks.

C. Dissimilarities Between the Trade Channels for the Marks

Applicant's cosmetic gel bearing the DERMOPLUS GEL mark will be widely offered in the make-up and cosmetics aisles of stores such as grocery stores and pharmacies, and will be available on our website. In contrast, it appears that the trade channels of the goods bearing the DERMA PLUS mark are/were offered in very specific stores as shown on Registrant's website, and do not appear available for purchase on-line. Additionally, it appears the only goods sold by Registrant now are under the name "Derma Shield" and "Derma Shield Plus," and no mention of DERMA PLUS is made on Registrant's website. *See* Exhibit B of Exhibit 19 previously made of record. As Exhibit A of Exhibit 19 shows, the DERMA PLUS medicated lotion is intended for First Aid purposes, it can be assumed that the medicated lotions sold under the DERMA PLUS mark are/were sold in the same aisles as first-aid kits or antiseptics, and would not be confused with goods sold in the make-up aisle.

As such, it is respectfully submitted that Applicant's goods travel in a channel of trade wholly diverse from those which would be expected for the goods of the cited mark. Moreover, as the evidence of record indicates that the Applicant's channel of trade for its goods are

completely distinct from the goods of the cited mark, it is submitted that their respective goods would not be encountered by the same persons in situations that would create the incorrect assumption that such goods originate from the same source and, accordingly, this *du Pont* factor also favors registration of the Applicant's mark.

D. The Marks' Goods are Marketed Differently

The goods offered in connection with the DERMOPLUS GEL mark will be marketed through Applicant's website, at tradeshows, through social media, and other traditional marketing venues. Although the Registrant's goods are marketed via a website hosted at www.dermashieldusa.com, the DERMA PLUS mark does not appear to be actively marketed as the name of the goods on Registrant's website appears to have changed to "Derma Shield Plus." *See* Exhibit B of Exhibit 19 previously made of record.

As such, it is respectfully submitted that this *du Pont* factor also favors registration of the Applicant's mark.

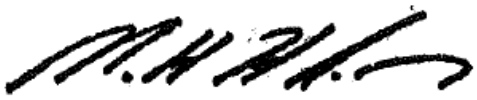
IV. CONCLUSION

In conclusion, based upon the foregoing it is submitted that the *du Pont* factors addressed herein favor registration of the Applicant's mark. The goods themselves are completely distinct and do not travel in similar trade channels or marketing channels such that they would be encountered by the same class of purchasers or members.

WHEREFORE it is respectfully requested that the board review the file of the instant proceedings, remove as an impediment the cited mark, and approve the instant application for publication upon the Principal Register.

Respectfully submitted this 9th day of January, 2015

THE TRADEMARK COMPANY, PLLC



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